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Qualitex Co. v. Jacobson Prods., Inc.: The Supreme Court “Goes for the Gold” and Allows Trademark Protection for Color Per Se

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COMMENT

Qualitex Co. v. Jacobson Prods., Inc.: The Supreme Court "Goes for the Gold" and Allows Trademark Protec- tion for Color Per Se

INTRODUCTION

When a consumer sees a product with a particular coloration, the consumer usually believes the color to be mere decoration, not an indication of the product's source.¹ In other words, consumers do not automatically think of color as a trademark.² However, there are situations in which color may act as a trademark, such as the color pink for fibrous glass insulation³ or blue for sugar-substitute sweetener packets.⁴ Although a color may be an unusual trademark compared to more standard word marks, courts have noted that the Lanham Act significantly broadened the range of trademarks that can be federally registered.⁵ For example, some types of trademarks that previously were unorthodox, but are now registrable in the United States Patent and Trademark Office ("PTO") are sounds,⁶ smells,⁷ product shapes⁸ and the location of

1. See Anthony V. Lupo, *The Pink Panther Sings the Blues: Is Color Capable of Trademark Protection?*, 21 MEMPHIS ST. U. L. REV. 637, 663-664 (1991).

2. The Lanham Act (The Trademark Act of 1946, 15 U.S.C. §§ 1051-1127 (1988 & Supp. V 1993)), defines a trademark as "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others. . . ." 15 U.S.C. § 1127 (1988).

3. See *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985) (granting trademark registration for the color pink as applied to Owens-Corning's Fiberglas® insulation).

4. See *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990).

5. See, e.g., *Owens-Corning*, 774 F.2d at 1119 ("Under the Lanham Act trademark registration became available to many types of previously excluded indicia"); J. THOMAS MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION*, § 25.1, at 25-4 to -5 (3d ed. 1995) ("Today, the law of unfair competition and trademarks has progressed . . . to encompass any form of competition or selling which contravenes society's current concepts of 'fairness'") (footnotes omitted).

6. Registration No. 916,522 (July 13, 1971) and Registration No. 523,616 (Apr. 4,

a tag on goods.⁹ Most recently, the United States Supreme Court reversed the United States Court of Appeals for the Ninth Circuit's ban on color trademarks by granting trademark protection for color alone, or color per se, in *Qualitex Co. v. Jacobson Prods. Co.*,¹⁰ a case in which Jacobson Products Co. ("Jacobson") was found to have infringed the color trademark of Qualitex Co. ("Qualitex"). This decision resolved the split among the circuits regarding trademark protection for color alone.¹¹

A color per se trademark is a color used in a uniform, non-distinctive manner, and not in conjunction with any symbol.¹² The idea that colors in combination with symbols, such as a red triangle, can be trademarks has been long recognized,¹³ but color alone trademarks are relatively new.

This Comment argues that the United States Supreme Court in *Qualitex* was essentially correct in following the guidance provided by the Federal and Eighth Circuits, which have approved or adopted color per se as a trademark, rather than the Ninth and Seventh Circuits, which have denied trademark protection. Part I discusses the pre-*Qualitex* jurisprudence relating to color alone marks. Part II discusses the facts and procedural history of *Qualitex*, followed

1950) (the musical notes G, E, C for the National Broadcasting Corp.); see George Gottlieb, *In case You Missed It . . .*, 62 TRADEMARK REP. 605, 605 & n.2 (1972).

7. *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990) (dealing with fragrance applied to sewing thread and embroidery yarn).

8. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (dealing with shape of a household cleaner bottle).

9. *In re Levi Strauss & Co.*, 165 U.S.P.Q. (BNA) 348 (T.T.A.B. 1970).

10. 115 S. Ct. 1300 (1995), *rev'g* 13 F.3d 1297 (9th Cir. 1994).

11. *Compare, e.g., NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990) and *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297 (9th Cir. 1994) (denying trademark protection for color alone) with *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) and *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993) (upholding trademark protection for color alone).

12. MCCARTHY, *supra* note 5, § 7.16, at 7-66.

13. See *NutraSweet Company v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990) (a color "may be protected if it is used in connection with some symbol or design or impressed in a particular design, as a circle, square, triangle, a cross, or a star" (citing *Barbasol Co. v. Jacobs*, 160 F.2d 336, 338 (7th Cir. 1947))); see also Craig Summerfield, *Color as a Trademark and the Mere Color Rule: The Circuit Split for Color Alone* 68 CHI.-KENT L. REV. 973, 979 (1993) ("Color in design is granted registration").

by an analysis of the arguments presented by both parties to the Supreme Court. Part III discusses the Supreme Court's decision and how the reasons for allowing color trademarks were persuasive to the Court. Part IV analyzes the Supreme Court's decision and concludes that the Court has left color marks with less than ideal trademark protection.

I. PRE-*QUALITEX* JURISPRUDENCE

Prior to 1985, no United States court had granted trademark protection to color alone.¹⁴ This may be because of the Supreme Court's comment in 1906 that "[w]hether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may, if it is impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this."¹⁵ Even after the liberalizing effect of the Lanham Act in 1946,¹⁶ however, courts were still reluctant to grant trademark protection or registration for color alone.¹⁷

In 1985, the United States Court of Appeals for the Federal Circuit ("CAFC"), in *In re Owens-Corning Fiberglas Corporation*,¹⁸ was the first circuit court to hold that the color of goods may serve as a trademark if the statutory requirements are met.¹⁹ The *Owens-Corning* court considered whether the color of Owens-

14. See Lawrence B. Ebert, *Trademark Protection in Color: Do it by the Numbers!*, 84 TRADEMARK REP. 379 (1994).

15. A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166, 171 (1906); see also Ebert, *supra* note 14, at 380-81.

16. See *supra* notes 5-9 and accompanying text.

17. See Ebert, *supra* note 14, at 384; see also Michael B. Landau, *Trademark Protection for Color Per Se After Qualitex Co. v. Jacobson Products Co.: Another Grey Area in the Law*, 2 U.C.L.A. ENT. L. REV. 1, 6, n.20 (1995) (collecting cases denying trademark protection for color alone).

18. 774 F.2d 1116 (Fed. Cir. 1985).

19. *Id.* at 1122. For example, a trademark is not registrable if it is merely descriptive of the product. 15 U.S.C. §1052(e) (1988). Registrable trademarks include "arbitrary" or "fanciful" marks that do not describe the goods and "descriptive" marks, which are registrable if they become associated with the goods in the minds of consumers. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976); see also *infra*, notes 23-24 and accompanying text for a discussion of secondary meaning and descriptive marks.

Corning's highly popular pink fibrous glass insulation acted as a trademark.²⁰ Owens-Corning used the color in television and print advertisements depicting the Pink Panther cartoon character alongside Owens-Corning's insulation with slogans such as, "Put your House in the Pink."²¹

The CAFC determined that the pink color alone, without any other words or symbols, signified to the consumer that the insulation came from a particular manufacturer.²² In such a case, the court determined that the color is considered to have "secondary meaning."²³ The color identified the source of the goods, as required by the Lanham Act.²⁴

Since *Owens-Corning*, the Eighth Circuit and other courts followed the CAFC's lead and allowed trademark protection for color per se, while others, such as the Seventh and Ninth Circuits, maintained the traditional view that color per se is not protectable.²⁵ This split resulted in the inconsistent enforcement of national trademark rights,²⁶ prompting the United States Supreme Court to grant certiorari in *Qualitex* to decide whether the Lanham Act prohibits the registration of color alone trademarks.²⁷ As a result of the Supreme Court's unanimous decision on March 28, 1995 that a

20. *Owens-Corning*, 774 F.2d at 1118.

21. See *id.* at 1125-26 (discussing Owens-Corning's advertising expenditures of more than \$42 million over a 10-year period, including ads during many major television events).

22. *Id.* at 1127.

23. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 120 L.Ed.2d 615, 622 n.4 (1992) ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself") (quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851, n. 11 (1982)); see also MCCARTHY, *supra* note 5, at § 11.09; Ebert, *supra* note 14, at 385 n.44 ("In the context of trademark law, secondary meaning refers to meaning, acquired in the market place, which has taken on primary importance. It is equivalent to an association between the trademark and the source of goods such that a consumer would more likely associate the goods with their source than with the earlier-in-time primary [descriptive] meaning.").

24. 15 U.S.C. § 1127 (1988) (a trademark, by definition, must "indicate the source of the goods, even if that source is unknown").

25. See Landau, *supra* note 17, at 2; Ebert, *supra* note 14, at 393.

26. See Summerfield, *supra* note 13, at 977-978.

27. *Qualitex Co. v. Jacobson Prods. Co.*, 115 S.Ct. 1300, 1302 (1995).

blanket prohibition on color alone trademarks is inappropriate, color per se is now clearly eligible for federal registration and considered valid in all circuits.²⁸

II. THE FACTS AND PROCEDURAL HISTORY OF QUALITEX

A. *The District Court Considers Green-Gold*

In 1990, Qualitex Company sued Jacobson Products Co., Inc., in federal court for trade dress infringement and unfair competition.²⁹ In the 1950s, Qualitex began manufacturing and selling press pads for use on dry cleaning presses.³⁰ To distinguish their Sun Glow® press pads from those of other manufacturers, Qualitex instructed the finisher of the cover fabric to dye the fabric a specific shade of green-gold,³¹ which was technically described as "brass #6587."³² Since Qualitex began manufacturing the pads, the press pads have always had the same green-gold color.³³

To help promote the Sun Glow® pads and identify them with Qualitex, the company used the specific shade of green-gold in its marketing efforts.³⁴ The green-gold color had been used in color advertisements for the pads in the leading trade publications since 1970.³⁵ Qualitex prepared its bulletins, trade show flyers, brochures and mailers with the green-gold color.³⁶ Further, when displaying its wares in trade shows, Qualitex draped its booth with the green-gold cover material to further identify the particular color with Qualitex press pads.³⁷ Overall, from 1960 to 1990, Qualitex expended over \$1.6 million for advertising the green-gold color and promoting it at trade shows.³⁸

28. *Id.* at 1308.

29. *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457 (C.D. Cal. 1991).

30. *Id.*

31. *Id.*

32. *Id.*

33. *Id.* at 1458.

34. *Id.*

35. *Id.*

36. *Id.*

37. *Id.*

38. *Id.*; see also Ebert, *supra* note 14, at 386 (citing advertising expenditures as one

Jacobson has been in the dry cleaning and garment industry business since the early 1950s. In 1989, Jacobson decided to manufacture its own press pads.³⁹ With a swatch of the Qualitex material as a sample, Jacobson tried to obtain the same material with the same color.⁴⁰ Jacobson claimed to want the material for pads to be sold in foreign markets, so a third party supplied Jacobson with seven hundred yards of Qualitex green-gold "seconds" from the same fabric finisher used by Qualitex.⁴¹ Once that initial shipment ran out, the Qualitex fabric finisher refused to supply any more, noting that the green-gold color belonged to Qualitex.⁴² Jacobson then approached another mill to have the Qualitex swatch analyzed and duplicated, resulting in a shipment of over five thousand yards of green-gold material, which appeared on the market in approximately July 1989 as Jacobson "Magic Glow" pads.⁴³ While the color was closely matched to Qualitex' pads, the United States District Court for the Central District of California found that the Jacobson "Magic Glow" pads were of inferior quality in many other respects when compared to the Sun Glow® pads.⁴⁴

After filing its complaint against Jacobson with the district court, Qualitex filed with the PTO to obtain registration for the green-gold color for press pads.⁴⁵ The trademark was subsequently registered, granting to Qualitex the statutory benefits of a trademark registration.⁴⁶ These benefits include a registration certificate, which is *prima facie* evidence of: (1) the validity of the trademark; (2) Qualitex' ownership of the trademark; and (3) Qualitex' exclu-

of the factors considered by courts in assessing whether a mark has acquired secondary meaning).

39. *Id.* at 1458.

40. *Id.*

41. *Id.* at 1459. "Seconds" can be production overruns not sent to the original purchaser.

42. *Id.*

43. *Id.* While "Magic Glow" sounds superficially like a knock-off of "Sun Glow," there was at least some evidence presented to the Supreme Court that Jacobson's "Magic" line of products was well known in the industry. See *Qualitex*, No. 93-1577, Brief for Respondent, 1994 WL 687525 at *3. The District Court did not mention this evidence.

44. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1458.

45. See *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1302 (1995).

46. Registration No. 1,633,711, issued Feb. 5, 1991.

sive right to use the registered mark in commerce on or in connection with the goods specified in the certificate.⁴⁷

In general, the district court found that as a result of Qualitex' long and exclusive use of the green-gold color in the marketplace, the color had acquired distinctiveness or "secondary meaning."⁴⁸ The concept of secondary meaning is based on the idea that marks that are descriptive of a product, such as the color yellow for the flavor lemon, are ordinarily not protectable as trademarks.⁴⁹ Some marks may be protected, however, if they have acquired an association, or secondary meaning, for the consuming public as an identifier of the source of the goods.⁵⁰ To establish secondary meaning for a mark, a party "must show that the primary significance of the [mark] in the minds of the consuming public is not the product but the producer."⁵¹ In *Qualitex*, the district court found that the green-gold color was sufficiently identified with Qualitex as the manufacturer of the press pad that the color had acquired secondary meaning.⁵² There was evidence that some purchasers had become so familiar with the green-gold color that they ordered the press pads over the telephone by merely describing its color.⁵³ There was also evidence that a large segment of the buyers at various dry cleaning establishments did not speak English and that they relied more on the color of the product to identify its source.⁵⁴

47. 15 U.S.C. § 1057(b) (1988).

48. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1461. See also *supra* notes 23-24 and accompanying text discussing secondary meaning.

49. See 15 U.S.C. § 1052(e)(1) (1988) (trademark shall be refused registration if it is "merely descriptive" of the goods).

50. *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983); see also 15 U.S.C. § 1052(f) (1988) ("nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.").

51. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938).

52. *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457, 1459 (C.D. Cal. 1991) (survey evidence showed that 39% of persons shown a Jacobson pad and asked, "What company or companies do you think makes this press pad?" answered "Qualitex." None of the respondents said Jacobson. When they were asked, "What is it that makes you think [Qualitex] makes this press pad?" numerous respondents stated "the color").

53. *Id.* at 1458.

54. *Id.* at 1461.

1. The Claims Against Jacobson

Qualitex initially sued Jacobson for unfair competition and trade dress infringement in violation of section 43(a) of the Lanham Act.⁵⁵ This claim was directed at the overall look of the product, including the color of the product in combination with the placement of the manufacturer's name on the product.⁵⁶ After Qualitex was issued its trademark registration, the company supplemented the complaint with a claim for trademark infringement under 15 U.S.C. § 1114.⁵⁷ This claim arose based solely on Jacobson's use of the green-gold color for its press pad. Jacobson filed a counterclaim for cancellation of Qualitex' registered trademark, claiming that Qualitex could not obtain a registration for color alone.⁵⁸

2. Trademark Infringement

In order to prevail on its trademark infringement claim, Qualitex had to prove that: (1) it possessed a valid trademark; and (2) that Jacobson's use of a similar mark was likely to cause confusion,⁵⁹ mistake or deception in the marketplace.⁶⁰ Due to the regis-

55. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1460-61. 15 U.S.C. § 1125(a) (Supp. V 1993) provides:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or combination thereof, or any false designation of origin . . . which—

(A) is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable

Id.

56. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1462.

57. *Id.*; 15 U.S.C. § 1114 (1988) ("Any person who shall, without the consent of the registrant—(a) use in commerce any . . . copy, or colorable imitation of a registered mark . . . to cause confusion, or to cause mistake, or to deceive . . . shall be liable . . .").

58. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1462; see 15 U.S.C. § 1119 (1988).

59. "Likelihood of Confusion" is a standard test for infringement. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2nd Cir.), cert. denied, 368 U.S. 820 (1961). In the Ninth Circuit, the factors to be considered in determining likelihood of confusion are as follows:

- 1) the strength of the plaintiff's mark;
- 2) relatedness of the goods;
- 3) similarity of the marks;

tered trademark, Qualitex had a presumption, granted by statute, of a valid trademark.⁶¹ The district court held that Jacobson had not met its burden to overcome that presumption, and thus, the color trademark was valid.⁶² The court found Jacobson had infringed Qualitex' trademark, at least in part, because Jacobson had *intended* to copy the trademark (the green-gold color) and confuse and deceive the marketplace with an identical color.⁶³

The district court also alluded to the doctrine of "color depletion," although it did not apply the doctrine to bar Qualitex' trademark.⁶⁴ According to this doctrine, if each competitor in a particular market is given a trademark monopoly to one color, there eventually would be no colors left for newcomers to use and they would be barred from competing.⁶⁵ Color depletion has been argued successfully in other cases, particularly when the applicant was attempting to trademark a primary color or a family of colors,

- 4) evidence of actual confusion;
- 5) marketing channels used;
- 6) likely degree of purchaser care;
- 7) defendant's intent in selecting the mark; and
- 8) likelihood of expansion of the product lines.

Landau, *supra* note 17, at 13, (citing, e.g., *Newton v. Thomason*, 22 F.3d 1455, 1461 (9th Cir. 1994)).

60. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1460 (citing *Charles Schwab & Co. Inc., v. Hibernia Bank*, 665 F. Supp. 800, 803 (N.D. Cal. 1987)).

61. See *supra* note 47 and the accompanying text.

62. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1460.

63. *Id.*

64. *Id.* This idea is also referred to as the "color exhaustion" or "color monopolization" doctrine. MCCARTHY, *supra* note 5, § 7.16[1]. See also William J. Keating, *Development of Evidence to Support Color-Based Trademarks*, 9 J. L. AND COMM. 1, 2 (1989); *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795 (3d Cir.), *cert. denied*, 338 U.S. 847 (1949) (denying protection for red and white can); Ebert, *supra* note 14 at 387; Summerfield, *supra* note 13, at 994-97.

65. External factors may also reduce the number of available colors. For example, with children's products, certain color combinations are particularly appealing and only certain dyes may be used in those products due to government toxicity standards. *Laureyssens v. Idea Group, Inc.*, 768 F. Supp. 1036, 1047 (S.D.N.Y. 1991). Similarly, in the food industry, dark colors on food packages tend to make the product look used, while pale colors make the product look old. DEAN B. JUDD & GUNTER WYSZECKI, *COLOR IN BUSINESS, SCIENCE AND INDUSTRY*, 32-33 (3d ed. 1975) (cited in Summerfield, *supra* note 13, 973 n.4). Thus, these colors would be effectively unavailable to competitors.

such as all shades of red.⁶⁶ Other decisions, such as the majority decision in *Owens-Corning*, have not allowed the color depletion doctrine to serve as a complete bar to registration of color alone marks.⁶⁷ Owens-Corning colored its insulation the now-famous pink color, while its competitors did not color their insulation.⁶⁸ Therefore, all other colors were available to competitors and there was no "competitive need" for the color in the marketplace.⁶⁹ Specifically, the CAFC noted that when there is no competitive need for the color, it is unreasonable to deny protection per se based on the color depletion theory.⁷⁰ To apply the "competitive need" test, courts must look at the marketplace to decide if there is a need for a particular color, or for coloration at all.⁷¹ If the colors have not been depleted, there will be no need for any particular color. This test, which is based on the facts of the marketplace, is unique to color trademarks.⁷² It recognizes that there may be situations where the supply of colors would be depleted, while for more standard word marks, for example, the supply of words is essentially

66. *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798 (3rd Cir.), *cert. denied*, 338 U.S. 847 (1949):

What the plaintiffs are really asking for, then, is a right to the exclusive use of labels which are half red and half white for food products. If they may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out.

Id.; see also *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727, 729 (6th Cir.), *cert. denied*, 203 U.S. 589 (1906) (denying protection for blue and red colors used on match tips, noting how quickly the primary colors would be monopolized).

67. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1120 (Fed. Cir. 1985) (color depletion theory is only useful when applied "appropriate[ly]"). See also Ebert, *supra* note 14, at 393 n.77 (discussing 1993 TTAB decision using color depletion theory as a bar to registration based on the facts); MCCARTHY, *supra* note 5, § 7.16[2], at 7-71 & nn. 10-10.1 (discussing TTAB decisions applying the rule of *Owens-Corning*).

68. *Owens-Corning*, 774 F.2d at 1122.

69. *Id.*

70. *Id.*

71. See *Owens-Corning*, 774 F.2d at 1122.

72. See Hugh C. Hansen, "Let Your True Colors Come Shining Through," *Or Does Federal Law Afford Trademark Protection to a Product's Color?*, 4 PREVIEW OF U.S. SUP. CT. CASES (ABA) 188 (1994) ("Owens-Corning, however, really represents an intermediate approach between a per se bar on the registration of color as a trademark and the normal treatment of color as any other indicator of a product's origin.").

limitless.

In *Qualitex*, the district court found no competitive need in the industry for the green-gold color, since other colors were equally usable.⁷³ Also, there are "hundreds or thousands of distinctive shades of greens, yellows, blues, and browns or tans available to the competitors without danger that recognizing plaintiff's trademark will hinder competition."⁷⁴ Thus, the color depletion argument was unsuccessful.

The district court also found that the green-gold color used by Qualitex was not "functional," i.e., the specific color did not serve any significant purpose other than as a trademark.⁷⁵ Functionality is another doctrine that has been used by some courts to deny protection for color marks.⁷⁶ For example, a trademark can be considered aesthetically functional, as was the case in *Deere & Co. v. Farmhand, Inc.*⁷⁷ In *Deere*, the United States Court of Appeals for the Eighth Circuit denied trademark protection for the color green in connection with front-end loaders because farmers already had green tractors made by various manufacturers.⁷⁸ The Eighth Circuit agreed with the lower court's finding that farmers would want their front-end loaders to match their tractors.⁷⁹ The lower court reasoned that since farmers wanted the product to be green, color served an aesthetic function, and was, therefore, "functional" be-

73. *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457, 1460 (C.D. Cal 1991).

74. *Id.*

75. See Ebert, *supra* note 14, at 384 ("[F]eatures which serve as functional components of the product such that the product neither could work nor would be desirable without them . . . are unprotectable by trademark law.") (footnote omitted).

76. *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983); *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569 (2nd Cir. 1959); see also Landau, *supra* note 17, at 18 (discussing several cases in which color trademarks were found functional and denied protection).

77. 560 F. Supp. 85 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983); see also Ebert, *supra* note 14, at 389 ("If such features serve solely identification purposes, trademark protection will be granted, but if such features contribute to the commercial success of the product, the feature may be viewed as aesthetically functional and denied trademark protection.").

78. *Deere*, 560 F. Supp. at 98. Front-end loaders are a type of farm truck.

79. *Deere*, 721 F.2d at 253.

cause it served a purpose other than as a source identifier.⁸⁰

Similarly, *Norwich Phamacal Co. v. Sterling Drug, Inc.*⁸¹ involved the popular medicine Pepto-Bismol® and a competitor's similarly pink-colored medication. The United States Court of Appeals for the Second Circuit determined that since the pink color of the liquid might serve some psychologically soothing function on the stomach, the color was functional.⁸² The color did more than identify the source of the product because it was important to the function of the product. Thus, trademark protection for the color was denied.⁸³

Functionality can also be considered in terms of utility. The United States Supreme Court has stated that a trademark will be denied protection if it is something that "is essential to the use or purpose of the article or that affects the cost or quality of the article."⁸⁴ One key reason for this utilitarian functionality doctrine is to avoid preempting the patent system, which is specifically designed and mandated to cover utilitarian innovations.⁸⁵ The patent system provides protection only to those who have invented something novel and then, only for a limited period.⁸⁶ In contrast, trade-

80. *Deere*, 560 F. Supp. at 98. Interestingly, in a later case, the Trademark Trial and Appeals Board granted a registration to Deere & Co. for green tractors with yellow wheels, noting that this color combination served no function. *In re Deere & Co.*, 7 U.S.P.Q.2d (BNA) 1401 (T.T.A.B. 1988).

In *Owens-Corning*, the CAFC cited *Deere* and the aesthetic functionality bar doctrine with apparent approval, noting that in certain situations, the bar might apply. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1121 (Fed. Cir. 1985). This was more recently confirmed in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994), in which the CAFC denied protection to black outboard motors, partially because consumers wanted the black color since it matched well with many different boat colors. *Id.* at 1533.

81. 271 F.2d 569 (2d Cir. 1959).

82. *Id.* at 572 & n.7.

83. *Id.* at 573.

84. *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10 (1982), (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964)); see also *Ebert*, *supra* note 14, at 384-85 n.41 ("A feature is functional if it embodies the 'benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, or sponsored or endorsed a product.'") (citation omitted).

85. See *Keating*, *supra* note 64, at 10.

86. 35 U.S.C. §§ 101, 154 (1988).

marks may enjoy protection for a potentially infinite duration, which is inappropriate for technological innovations.⁸⁷ In *Owens-Corning*, for example, the CAFC concluded that the pink color applied to the insulation served no utilitarian purpose or function, so trademark protection was granted.⁸⁸

In *Qualitex*, the district court found that there was evidence supporting a need for some coloration on the press pad, for example, to hide scorch marks, and thereby showing that the color was somewhat functional).⁸⁹ However, Qualitex' particular shade of green-gold served this purpose no better or worse than other colors.⁹⁰ Indeed, many other manufacturers had been successfully coloring their press pads many different colors for years.⁹¹ Since neither functionality nor color depletion were bars to Qualitex' trademark, the court held that the trademark was valid and that it had been infringed by Jacobson.⁹²

3. Unfair Competition

Qualitex also claimed that Jacobson had engaged in unfair competition under section 43(a) of the Lanham Act.⁹³ Under section 43(a), a successful claim of unfair competition does not require a registered trademark, or even a trademark that could be registered.⁹⁴ Thus, it is considered to cover a broad range of actionable harms.⁹⁵

87. See *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 226, 231 (1964) (discussing that unfair competition laws should not be allowed to extend the limited patent monopoly).

88. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1121 (Fed. Cir. 1985) (functionality is tested by looking at: "(1) whether a particular design yields a utilitarian advantage, (2) whether alternative designs are available in order to avoid hindering competition, and (3) whether the design achieves economies in manufacture or use.").

89. *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457, 1460 (C.D. Cal. 1991).

90. *Id.*

91. *Id.* at 1458.

92. *Id.* at 1460.

93. See *supra* note 55.

94. 15 U.S.C. § 1125 (1988) (noting that in addition to words, terms, names, symbols and devices, any false designation of origin may be actionable). 15 U.S.C. § 1125 (a)(1).

95. *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 858 (1982).

In *Qualitex*, the district court found that since Jacobson had copied the "trade dress"⁹⁶ or overall appearance of the Qualitex pads, there was a likelihood of confusion by consumers as to the origin of the products, and found infringement under section 43(a).⁹⁷ In addition to copying the green-gold color, Jacobson had stamped "Magic Glow" on the side or skirt portion of the pad cover, the same portion of the pad where Qualitex stamps "Sun Glow."⁹⁸ Thus, the District Court granted an injunction against Jacobson based on findings of trademark and trade dress infringement.⁹⁹ Perhaps hoping to convince the Ninth Circuit that the traditional approach of not protecting color marks was proper, Jacobson appealed the decision to the United States Court of Appeals for the Ninth Circuit.¹⁰⁰

B. *The Ninth Circuit Reverses*

Before *Qualitex*, the Ninth Circuit had been receptive to the notion of trademark protection for color alone. In the 1987 decision in *First Brands Corp. v. Fred Meyer, Inc.*,¹⁰¹ the Ninth Circuit accepted the CAFC's analysis in *Owens-Corning* and noted the exception to the complete bar to color trademark protection.¹⁰² The Court of Appeals in *First Brands* did believe, however, that color depletion was a real danger and appeared to embrace the "competitive need" test espoused by *Owens-Corning*, allowing protection for color alone only in extraordinary situations, such as those in *Owens-Corning*.¹⁰³

96. See MCCARTHY, *supra* note 5, § 8.01[1], at 8-2 ("To determine trade dress infringement; the court must consider the total image or overall impression of plaintiff's product, package and advertising and compare this with the corresponding image or impression of defendant's product.") (footnote omitted); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2755 n.1 (1992) (trade dress "involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques") (citation omitted).

97. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1462.

98. *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1305 (9th Cir. 1994).

99. *Qualitex*, 21 U.S.P.Q.2d (BNA) at 1462.

100. *Id.* at 1300.

101. 809 F.2d 1378 (9th Cir. 1987).

102. *Id.* at 1382; see also Ebert, *supra* note 14, at 394 (noting that commentators view *First Brands* as an acceptance of *Owens-Corning*).

103. *First Brands*, 809 F.2d at 1382; see also *supra* notes 69-72 and accompanying

Six years later, the Ninth Circuit was confronted with a similar issue in *International Jensen, Inc. v. Metrosound U.S.A., Inc.*¹⁰⁴ In *International Jensen*, both parties' stereo speakers included blue "surrounds," which attach the speaker cones to the housings.¹⁰⁵ On the issue of whether color alone could be protected at all, the court specifically left the question open.¹⁰⁶ The court noted instead that many competitors' surrounds were colored, and therefore, consumers take particular care in choosing which product they prefer and which manufacturer they choose to patronize.¹⁰⁷ Further, when the overall appearance of the two speakers was considered, the Court concluded that there was no possibility of likelihood of confusion, and therefore, no protection for the blue color was warranted in that case.¹⁰⁸

In *Qualitex*, the Ninth Circuit once again addressed the color per se trademark issue. The Ninth Circuit admitted early in the decision that trademark protection for color alone was not explicitly barred by the Lanham Act.¹⁰⁹ The court, however, ignored the statutory breadth of the Lanham Act and decided that "the better rule" would be to block protection for color per se trademarks, relying on the color depletion theory, among others.¹¹⁰ The court distinguished its own decision in *First Brands* by commenting that *First Brands* was a trade dress suit, involving the overall image of the packaging, and not a trademark suit.¹¹¹ Further, while the court in *First Brands* had appeared to admit that *Owens-Corning* created

text discussing the competitive need test.

104. 4 F.3d 819 (9th Cir. 1993). An interesting side note to this case was that the Senior Circuit Judge for the Seventh Circuit, which had already rejected protection for color marks (*see NutraSweet Co. v. Stadt Corp.* 917 F.2d 1024 (7th Cir. 1990)), was sitting by designation and wrote the opinion for the Ninth Circuit. *International Jensen*, 4 F.3d at 821.

105. *International Jensen*, 4 F.3d at 821.

106. *Id.* at 824.

107. *Id.* at 825.

108. *Id.*

109. *Qualitex Co. v. Jacobson Prods. Co.* 13 F.3d 1297, 1301 (9th Cir. 1994).

110. *Id.* at 1301-02. The court also mentioned shade confusion, discussed *infra*, and the "adequate" protection already provided by claims under § 43(a) of the Lanham Act. *Id.* at 1302-03.

111. *Id.* at 1302.

an exception to the color per se bar for certain marks, the Ninth Circuit claimed that it was only referring to the exception in the context of a trade dress case.¹¹²

One of the key arguments against protection for color per se that the Ninth Circuit found persuasive was the "shade confusion" theory.¹¹³ This doctrine is based on the alleged difficulty of manufacturers and courts in determining when one color will infringe a color trademark that is similar although not identical.¹¹⁴ For example, in a hypothetical Qualitex-type situation, Jacobson might have wanted to avoid infringing Qualitex' distinctive mark in the green-gold color, rather than intentionally copying it. If Jacobson wanted to pick a green-like color to match its other products, the issue would arise as to whether the shade of green and the protected shade of green-gold would be close enough to constitute an infringement.

The court in *Owens-Corning* had already rejected this doctrine, noting that the Trademark Trial and Appeal Board ("TTAB") within the PTO has been able to decide several cases to date based on shade.¹¹⁵ The confusion issue would likely be treated as any other word mark, with help from expert testimony and the traditional "likelihood of confusion" test.¹¹⁶ Thus, according to some circuits before *Qualitex*, determining a shade confusion issue was similar to determining a word confusion issue.¹¹⁷

112. *Id.*

113. *See, e.g.,* NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 1027 (7th Cir. 1990); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1131 (Fed. Cir. 1985) (Bissell, J., dissenting); *see also* Landau, *supra* note 17, at 15; Summerfield, *supra* note 13, at 991-94.

114. *See, e.g.,* NutraSweet, 917 F.2d at 1027 ("How different do the colors have to be?"); *see also* MCCARTHY, *supra* note 5, § 7.16[1], at 7-68 to -70.

115. *Owens-Corning*, 774 F.2d at 1123, (citing, among others, *Youngstown Sheet & Tube Co. v. Armco Steel Corp.*, 170 U.S.P.Q. (BNA) 162 (T.T.A.B. 1971) (the "Board 'can make its own comparison' of grey and orange banded fence post versus orange banded pipe")).

116. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993) ("expert witnesses are available to testify regarding the similarity of the colors at issue"). *See supra* note 59 and accompanying text.

117. *See, e.g.,* *Owens-Corning*, 774 F.2d at 1123 ("[w]e agree with the Board that '[d]eciding likelihood of confusion among color shades . . . is no more difficult or subtle than deciding likelihood of confusion where word marks are involved'") (citation omit-

The Ninth Circuit, however, determined that drawing distinctions between close shades of color could present "unnecessary problems." The court declined, however, to specifically discuss why these potentially difficult questions were "unnecessary" while difficult word mark questions occur frequently.¹¹⁸ The court merely referred to other cases that discussed the shade confusion theory.¹¹⁹ Later in the decision, the court, in discussing trade dress, seemed to contradict itself by concluding that it was not error for the district court to conclude that "the range of tones of available distinctive suitable colors . . . is in the hundreds if not thousands."¹²⁰

Even though the Ninth Circuit denied the trademark infringement claims, the court upheld the district court's decision concerning trade dress, finding infringement and recognizing that Jacobson had willfully copied Qualitex' trade dress, including not only the color of Qualitex' product, but also elements such as the placement of the label on the product.¹²¹

The end result of the Ninth Circuit's decision was that the trademark infringement claim was reversed and Qualitex' previously valid trademark in the green-gold color for press pads was cancelled.¹²² This cancellation emphasized the problem of inconsistent rulings in this area, since the trademark was cancelled nationwide. If Qualitex had brought the suit in the Eighth or Federal Circuits, it would have retained its national rights.¹²³ On one level, Qualitex won the appeal, since the trade dress infringement claim under

ted); see also Lupo, *supra* note 1, at 663 ("[c]ourts can compare two color marks just as easily as comparing two word marks").

118. *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994).

119. *Id.* (referring to the *NutraSweet* decision and the dissent in *Owens-Corning*).

120. *Id.* at 1304. If there were thousands of distinct colors available, how could color depletion become a problem? The Ninth Circuit also accepted the injunction against Jacobson, which stated that Jacobson would not use the same green-gold color, "or so close to said color that it cannot be easily distinguished from the Qualitex color by the casual user." *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457, 1462 (C.D. Cal. 1991). Obviously, the court would be willing to judge shades for the injunction, but not for trademark registration or infringement—a seemingly nonsensical approach.

121. *Qualitex*, 13 F.3d at 1304.

122. *Id.* at 1305.

123. See *supra* note 11.

section 43(a) was affirmed, as was the injunction preventing Jacobson from further use of the infringing trade dress.¹²⁴ However, if Jacobson were to have performed a simple change to its trade dress, such as moving the placement of the label, Qualitex would have only been able to rely on the identical color of the competing pad for its claim and would probably have lost any future lawsuits in, at least, the Seventh and Ninth Circuits. Thus, Jacobson would have been able to confuse consumers into buying its product at the expense of Qualitex.

Realizing its hollow victory, Qualitex petitioned the United States Supreme Court and was granted certiorari.¹²⁵ The sole issue on appeal was "[w]hether the Lanham [Act] permits the registration of a trademark that consists, purely and simply, of a color."¹²⁶ In addition to the petitioner's and respondent's briefs, the Supreme Court allowed ten amicus briefs to be filed.¹²⁷

C. The Supreme Court Takes the Appeal

1. The Petitioner's Brief

Qualitex initially focused on the plain meaning of the Lanham Act to support its position that the Lanham Act allows protection for color alone.¹²⁸ Qualitex argued that, as the Ninth Circuit conceded, color alone is encompassed by the definition of "trademark" in the Lanham Act.¹²⁹ Qualitex further noted that section 2 of the Lanham Act provides that "[n]o trademark by which the goods of

124. *Qualitex*, 13 F.3d at 1305.

125. *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1302 (1995).

126. *Id.*

127. Briefs were filed in support of Qualitex by: Bar Association of the District of Columbia; B.F. Goodrich Company; The Crosby Group, Inc.; Dr. Pepper/Seven-Up Corporation; Hand Tool Institute; Intellectual Property Owners; International Trademark Association; Owens-Corning Fiberglas Corporation; United States. Briefs were filed in support of Jacobson by the Private Label Manufacturers Association. Hansen, *supra* note 72.

128. *Qualitex*, 13 F.3d at 1301; *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 222 (8th Cir. 1993).

129. See *Qualitex*, 13 F.3d at 1301; *Qualitex*, No. 93-1577, Petitioner's Brief on the Merits, at *10.

the applicant may be distinguished from the goods of others shall be refused registration on the principal register *on account of its nature*" unless the mark falls within certain statutory exceptions.¹³⁰ None of the exceptions prohibits a color trademark from registration.

Despite this clear language, and despite the acknowledgement of the Ninth Circuit that the Lanham Act does not explicitly bar the registration of color trademarks, the Ninth Circuit decided to follow its "better rule" and bar color marks altogether.¹³¹ Qualitex argued that the Supreme Court had stated several times that courts may not substitute their own opinion of what the law should be for the unambiguous language of a statute.¹³² Since the Ninth Circuit did not provide any statutory authority for its decision to bar color trademarks, while admitting that authority existed for allowing them, Qualitex argued that the Ninth Circuit's decision was erroneous.¹³³

Expanding on the interpretation of the statute, Qualitex argued that congressional intent, evidenced by the legislative history of the Lanham Act, supported granting trademark protection for color trademarks.¹³⁴ Qualitex explained that when Congress was considering the Lanham Act, it considered and rejected a definition of

130. 15 U.S.C. § 1052 (1988 & Supp. V 1993) (emphasis added). The exceptions are: (1) scandalous or immoral matter; (2) national symbols; (3) the name or portrait of a living person without consent; (4) marks which are confusingly similar to previously registered marks; and (5) marks which are merely descriptive, geographically descriptive, or deceptively misdescriptive. See 15 U.S.C. § 1052(a)-(e); *Qualitex*, Petitioner's Brief on the Merits, at *13.

131. See *supra* notes 109-121 and accompanying text.

132. Petitioner's Brief on the Merits, at *13, (citing *Freytag v. Commissioner of Internal Revenue*, 501 U.S. 868, 873 (1991); *Mobil Oil Corp. v. Higginbotham*, 436 U.S. 618, 625-626, *reh'g denied*, 439 U.S. 884 (1978); *Kleppe v. New Mexico*, 426 U.S. 529, 541 n. 10, *reh'g denied*, 429 U.S. 873 (1976)). Qualitex also quoted an old Supreme Court case:

It is elementary that the meaning of a statute must, in the first instance, be sought in the language in which the [A]ct is framed, and if that is plain, and if the law is within the constitutional authority of the law-making body which passed it, the sole function of the courts is to enforce it according to its terms. *Caminetti v. United States*, 242 U.S. 470, 485 (1917).

133. Petitioner's Brief on the Merits, at *14.

134. *Id.* at *14.

"trademark" that was narrower than that of prior Acts.¹³⁵ Instead, Congress adopted language permitting the registration of any indicia that can function as a trademark, including, but not limited to, words, names, symbols, or devices.¹³⁶

Qualitex further explained that the legislative history of the more recently enacted Trademark Law Revision Act of 1988 ("TLRA")¹³⁷ also supports the theory that Congress intended to permit registration of color marks.¹³⁸ When Congress was considering the TLRA, *Owens-Corning* had already been decided and the PTO had registered a number of color trademarks.¹³⁹ Even with the existing interpretations of the Lanham Act, of which Congress must have been aware, Congress could have amended the Lanham Act to preclude color registrations. Instead, Qualitex pointed out, Congress "intentionally retained . . . the words 'symbol or device' so as not to preclude registration of colors, shapes, sounds or configurations where they function as trademarks."¹⁴⁰

135. *Id.* at *15, (citing *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 197 (1985) (citing H.R. CONF. REP. No. 2322, 79th Cong., 2d Sess. 4 (1946))).

136. See 15 U.S.C. § 1127 (1988). Under the definition of trademark, the statute states: "The term 'trademark' includes any word, name, symbol, or device," while the definition of a service mark states "The term 'service mark' means any word, name, symbol, or device" (emphasis added). *Id.* The definitions of certification mark and collective mark also use "means" instead of "includes." This may imply that the definition of a trademark is not intended to be limiting.

137. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, 3946 (1988).

138. Petitioner's Brief on the Merits, at *16.

139. *Id.* (citing, e.g., Registration No. 1,447,706, dated July 14, 1987, for the color orange as applied to inserts for finger holes in bowling balls; and several other registrations). The revision of the Lanham Act closely tracked the United States Trademark Association's (now the International Trademark Association) *Trademark Review Commission Report and Recommendation to USTA President and Board of Directors*, 77 TRADE-MARK REP. 375 (1987), which stated that the definition of trademark should not preclude registration of "such things as color, shape, smell, sound or configuration." *Id.* at 421.

140. Petitioner's Brief on the Merits at *17-18, (citing S. Rep. No. 515, 100th Cong., 2d Sess., 44 (1989), reprinted in 1988 U.S.C.C.A.N. 5577, 5607). Congress also evidenced similar intent in approving the North American Free Trade Agreement, which provides, "For purposes of this Agreement, a trademark consists of any sign, or combination of signs, capable of distinguishing the goods or services of one person from those of another, including personal names, designs, letters, numerals, colors, figurative elements, or the shape of goods or their packaging." Petitioner's Brief on the Merits, at *18 (quoting North American Free Trade Agreement, Dec. 17, 1992, Art. 1708(1), 32 I.L.M. 605, 670 (1993) implemented by the North American Free Trade Implementation Act, Pub. L.

Further bolstering Qualitex' interpretation of the statute is the construction given the statute by the agency charged with administering it—the PTO.¹⁴¹ Qualitex argued that over the years, and in particular in the years since *Owens-Corning*,¹⁴² the Trademark Office has registered color trademarks when the statutory criteria are met and refused registration when they are not.¹⁴³ The Patent and Trademark Office has even developed specific internal procedures for handling color trademark applications.¹⁴⁴ These procedures follow the interpretation of *Owens-Corning* and its "competitive need" test as follows: "The burden of proof in such a case is substantial . . . [W]here the applicant seeks registration for overall color, registration is refused irrespective of any showing of acquired distinctiveness if there is a competitive need for colors to remain available in the industry."¹⁴⁵

Qualitex argued that this construction should not be disturbed by a court if it reflects a plausible construction of the plain language of the statute and does not otherwise conflict with the expressed intent of Congress.¹⁴⁶ In many areas of administrative law, this principle may be true. However, where the PTO is concerned, the courts have been more than willing to override the Office's construction and impose their own.¹⁴⁷ Thus, even though the "deference" portion of Qualitex' argument appeared to carry little weight, both the language of the statute and the congressional intent weighed heavily in Qualitex' favor.

No. 103-182, 1993 U.S.C.C.A.N. (107 Stat.) 2057 (emphasis added)).

141. Petitioner's Brief on the Merits, at *19.

142. See *supra* notes 18-22 and accompanying text.

143. Petitioner's Brief on the Merits, at *19 n.21 (citing, e.g., *British Seagull, Ltd. v. Brunswick Corp.*, 28 U.S.P.Q.2d (BNA) 1197 (T.T.A.B. 1993) (refusing to register black for outboard marine engines where the color was functional—the color helped to make the engine look smaller and blended well with other colors—and lacked secondary meaning)). See also *supra* note 19 discussing the statutory criteria.

144. TRADEMARK MANUAL OF EXAMINING PROCEDURE, § 1202.04(e) (2d ed. 1993).

145. *Id.*

146. Petitioner's Brief on the Merits, at *22 (quoting *Rust v. Sullivan*, 500 U.S. 173, 184 (1991)).

147. Hansen, *supra* note 72 ("[I]n day-to-day intellectual property, deference usually is not given either to the Patent and Trademark Office or to the Copyright Office.").

The Qualitex brief concluded with various policy reasons for registering color trademarks.¹⁴⁸ In addition to color depletion¹⁴⁹ and shade confusion,¹⁵⁰ Qualitex stressed the basic nature of trademarks, which is to provide consumers with information relating to the source of the goods to aid in the selection of those goods.¹⁵¹

2. The Respondent's Brief

In its brief, Jacobson took a position that seemed difficult to defend. In the first sentences of the brief, Jacobson appeared to concede victory to Qualitex:

This court has granted certiorari on one issue: whether the Lanham Act prohibits the registration of color as a trademark. Respondent would answer "no." It is not arguable that the Lanham Act allows the registration of color as a trademark, when the use of the color functions as a trademark.¹⁵²

Instead of arguing the issue on appeal, Jacobson contended that the factual determinations made in the courts below were erroneous.¹⁵³ Specifically, Jacobson argued that the green-gold color on the Qualitex pads, or any mere product coloration for that matter, could not function as a trademark.¹⁵⁴ Jacobson further argued that mere product color is not a "symbol" or "device" and thus could not be a "trademark" use of the color, as defined by statute.¹⁵⁵

Jacobson also attempted to turn Qualitex' legislative history argument around. Jacobson argued that while Congress was con-

148. Petitioner's Brief on the Merits at *22.

149. *See id.* at *25.

150. *See id.* at *25-*26.

151. *Id.* at *23-*24 ("Failure to protect indicia on which consumers rely to obtain the product they desire will result in confusion as counterfeit products freely enter the market. The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.").

152. *Qualitex*, No. 93-1577, Brief for Respondent, at *1.

153. *See, e.g., id.* at *11.

154. *Id.* at *1-*2.

155. *Qualitex*, Brief for Respondent, at *10.

sidering the 1988 TLRA, it apparently knew about the *Owens-Corning* decision,¹⁵⁶ the Trademark Commission's report,¹⁵⁷ and the PTO's interpretation of the statute.¹⁵⁸ In such an informed atmosphere, Congress could have explicitly included color alone as a registrable trademark, but did not, implying that color was to be excluded.¹⁵⁹

Continuing its argument that the green-gold color did not function as a trademark, Jacobson argued that since the use of color for press pads is necessary for the marketability of the product, the color is purely functional and therefore barred from registration under the functionality doctrine.¹⁶⁰ Jacobson also reiterated the traditional concepts of color depletion and shade confusion.¹⁶¹

Again trying to shift the focus from the actual issue on appeal, on which they had already admitted defeat, Jacobson attempted to distinguish *Owens-Corning* from the case at bar by stating that the holding in *Owens-Corning* "should be limited to the facts of that case." This only emphasized that the issue on appeal, which was the Ninth Circuit's denial of trademark protection for color per se and not just in this case, should be decided in Qualitex' favor.

3. The Petitioner's Reply Brief

In its reply brief, Qualitex quickly pointed out that Jacobson had essentially conceded the case.¹⁶² Qualitex further noted that United States Supreme Court rules preclude raising additional questions or changing the substance of the questions certified for review in any brief on the merits.¹⁶³ Qualitex suggested that the Ninth Circuit should be reversed on the sole question presented, since

156. See *supra* notes 18-22 and accompanying text.

157. See *supra* note 139.

158. See notes 144-145 and accompanying text.

159. *Qualitex*, Brief for Respondent, at *11 n.8.

160. *Id.* at *20. See also *supra* notes 75-88 and accompanying text.

161. Brief for Respondent, at *21-*23; see also *supra* notes 64-67 and 113-117 and accompanying text.

162. *Qualitex*, No. 93-1577, Petitioner's Reply Brief, at *1.

163. *Id.* at *1-*2, (citing Supreme Court Rules 24.1(a) and 24.2).

both parties agreed on that answer.¹⁶⁴

In addition to attacking Jacobson's arguments and newly raised factual issues, Qualitex again pointed out that the registration of color trademarks serves the underlying policies of the Lanham Act.¹⁶⁵ Especially in Qualitex' case, in which the green-gold color identified its product for over thirty years, denying protection would promote confusion in the marketplace by depriving customers of the trademark they rely on to choose the desired product.¹⁶⁶

Given the briefs that the Supreme Court had to consider, complete with Jacobson's self-defeating and procedurally unusual arguments, it would have been difficult for the Court not to acknowledge that the Lanham Act permitted trademark registration for color alone.

III. THE SUPREME COURT'S DECISION

The decision of the United States Supreme Court in *Qualitex* was unanimous and the sole opinion was delivered by Justice Breyer.¹⁶⁷ The Court, in its decision, echoed the points made by Qualitex in its briefs concerning the statutory language of the Lanham Act.¹⁶⁸ Referring to section 45 of the Lanham Act,¹⁶⁹ the

164. *Id.* at *2.

165. Qualitex cited the various Amicus briefs filed in support of their position, listing the following policy interests served by registration for color marks:

1) Color registration will protect the ability of consumers to distinguish between competing producers.

2) Denying exclusive rights and registration to a color which has acquired secondary meaning would promote confusion and deception.

3) Registration of color advances the Lanham Act's objective of registering as many marks in use as practicable so competitors may effectively search the marks in use and avoid conflicts.

4) Denying registrability to color is inconsistent with global harmonization in trademark law.

5) Permitting color registration supports the United States' advocacy to other countries that recognize color as a trademark.

Id. at *13 n.16 (citations omitted).

166. Petitioner's Reply Brief at *13; *see also supra* notes 53-54 and accompanying text.

167. *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995).

168. *See id.* at 1302-03.

169. Trademarks "includ[e] any word, name, symbol, or device, or any combination thereof." 15 U.S.C. § 1127 (1988).

Court stated that “[s]ince human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”¹⁷⁰ Noting that shapes, sounds and fragrances can act as symbols under the Lanham Act, the Court could find no reason why color could not do the same.¹⁷¹

The Court then agreed with Qualitex that color is capable of satisfying the most important part of the statutory definition of a trademark, which is to act as a source identifier.¹⁷² As with other “descriptive” marks that do not necessarily indicate source, color may, over time, develop secondary meaning, such that “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”¹⁷³ Importantly, the court indicated that a product’s color can not be considered a “fanciful,” “arbitrary,” or “suggestive” mark.¹⁷⁴ In practical terms, this means that product color will not be able to be registered without acquiring secondary meaning. Manufacturers will not be able to register their marks upon product initial introduction to the marketplace. While this may present some inconvenience in obtaining full trademark protection for color alone, the Supreme Court made it clear that such protection is available. The Court stated that it is the source-distinguishing ability of a mark—not its status as color, shape, fragrance, word, or sign—that permits it to serve as a trademark.¹⁷⁵ Thus, the Court could not find, in basic trademark objectives, a reason to disqualify absolutely the use of a color as a mark.¹⁷⁶

The Court also made it clear that the functionality doctrine is alive and well, even with respect to color trademarks, but it is not an absolute bar.¹⁷⁷ The Court followed its previous rulings in the

170. *Qualitex*, 115 S. Ct. at 1302-03.

171. *Id.* at 1303.

172. *See* 15 U.S.C. § 1127 (1988); *supra* note 2.

173. *Qualitex*, 115 S. Ct. at 1303 (quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

174. *Id.* (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976) (Friendly, J.)).

175. *Id.* at 1304.

176. *Id.*

177. *Id.*

functionality area by reiterating that,

[i]n general terms, a product feature is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.¹⁷⁸

The Court also realized that while color may sometimes play an important role in the desirability of a product that is unrelated to source identification, sometimes it might not.¹⁷⁹ In those latter instances where color is not essential to the product's use or purpose and does not affect cost or quality, functionality will not be a bar to the use or registration of color alone.¹⁸⁰ The Court followed the findings of the district court, which were accepted by the Ninth Circuit, that Qualitex' green-gold color had acquired secondary meaning and that the specific color served no other function.¹⁸¹

Perhaps settling the color alone trademark controversy forever, the Court then attacked each argument used by Jacobson and the courts denying protection for color alone, beginning with shade confusion.¹⁸² The Court cited cases that have already made the "difficult" shade confusion determinations.¹⁸³ Noting that courts decide difficult questions on the similarity of words, phrases or symbols, the Court concluded that shade questions are not "special" and should be treated like any other trademark questions.¹⁸⁴

178. *Id.* (citing *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10 (quotation marks omitted)).

179. *Id.*

180. *Id.*

181. *Id.* at 1305. The Court made note of the fact that some color is important on the press pads, but agreed with the district court that no "competitive need" existed for the green-gold color, since other colors were equally usable. *Id.* Although only dicta and placed in a parenthetical comment, this likely serves as an affirmation of the "competitive need" test advanced by the CAFC and followed by the Patent and Trademark Office and TTAB.

182. *Qualitex*, 115 S. Ct. at 1305.

183. *Id.*

184. *Id.* ("Legal standards exist to guide courts in making such comparisons. . . . We do not see why courts could not apply those standards to a color, replicating, if

The color depletion theory, however, did carry some weight with the Court. The Court noted that in some cases, the use of particular colors is necessary, such as with medical pills where the color serves to identify the type of medicine.¹⁸⁵ In such a case, the needed colors could be depleted and the functionality doctrine would apply. Since the color would be "essential to the use or purpose" of the product, it would not be protectable as a trademark.¹⁸⁶ However, these particular instances do not justify a blanket prohibition.¹⁸⁷ Courts simply need to apply the doctrine in a careful manner, with sensitivity to the effects on competition.¹⁸⁸ Citing to several district and circuit court decisions in which such care and sensitivity has already been successfully and properly exercised, the Court found no reason to apply a per se ban based on color depletion.¹⁸⁹

The Supreme Court also put to rest the notion that any pre-Lanham Act jurisprudence should be considered with respect to color alone trademarks.¹⁹⁰ The Court adopted many of the arguments put forth by Qualitex in its brief on the merits relating to the legislative history of the Lanham Act and subsequent congressional actions.¹⁹¹ Most notably, the Court stated that "the Federal Circuit was right" in *Owens-Corning* when it found that the Lanham Act "embodied crucial legal changes that liberalized the law to permit the use of color alone as a trademark (under appropriate circumstances)."¹⁹²

necessary, lighting conditions under which a colored product is normally sold" (citations omitted)).

185. *Id.* at 1306 (citing *Inwood Lab. Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 853, 857-58 & n.20 (1982)).

186. *Id.*

187. *Id.*

188. *Id.*

189. *Id.* (citing *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 98 (S.D. Iowa 1982), *aff'd* 721 F.2d 253 (8th Cir. 1983); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994), *cert. pending*, No. 94-1075; *Nor-Am Chemical v. O.M. Scott & Sons Co.*, 4 U.S.P.Q.2d (BNA) 1316, 1320 (E.D. Pa. 1987)).

190. *Qualitex*, 115 S. Ct. at 1307.

191. *See supra* part II.C.1.; *Qualitex*, 115 S. Ct. at 1307-08.

192. *Qualitex*, 115 S. Ct. at 1308.

The revisions to the Lanham Act made by the TLRA did not include explicit language permitting color alone trademarks, but that should not be interpreted as a lack of authority, as argued by Jacobson.¹⁹³ Rather, the Supreme Court concluded that when Congress re-enacted the terms "word, name, symbol, or device,"¹⁹⁴ "it did so against a legal background in which those terms had come to include color, and its statutory revision embraced that understanding."¹⁹⁵

Finally, the Court attacked Jacobson's argument that color can be adequately protected by "trade dress" claims under section 43(a) of the Lanham Act. In the Ninth Circuit, Qualitex had indeed received significant protection under "trade dress" infringement.¹⁹⁶ However, the Court understood that trademark registration confers a wealth of benefits that are not available under section 43(a).¹⁹⁷ These include the ability to prevent importation of confusingly similar goods,¹⁹⁸ constructive notice of ownership,¹⁹⁹ and incontestability after five years.²⁰⁰ Unable to find any reason why a blanket prohibition should be imposed on color alone trademarks, the Court decided that these marks should not be denied the statutory benefits Congress intended to bestow upon them.²⁰¹ Thus, the Court reversed the Ninth Circuit, validating Qualitex' registered trademark and holding Jacobson liable for trademark infringement.²⁰²

193. See *supra* note 159 and accompanying text.

194. 15 U.S.C. § 1127 (1988).

195. *Qualitex*, 115 S. Ct. at 1308. The Court also referred to the Senate Report accompanying the TLRA: The "revised definition intentionally retains . . . the words 'symbol or device' so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks." *Id.* (quoting S.REP. No. 100-515, 100th Cong., 2d. Sess., reprinted in 44 U.S.C.C.A.N. 5607 (1988)).

196. The Ninth Circuit affirmed the district court's injunction based only on trade dress, which is the same injunction Qualitex won on its trademark infringement claim. *Qualitex*, 13 F.3d at 1305.

197. *Qualitex*, 115 S. Ct. at 1308.

198. 15 U.S.C. § 1124 (1988).

199. 15 U.S.C. § 1072 (1988).

200. 15 U.S.C. § 1065 (1988).

201. *Qualitex*, 115 S. Ct. at 1308.

202. *Id.*

IV. THE SUPREME COURT FALLS A SHADE SHORT

The Supreme Court's decision in *Qualitex* followed the wide reach of the Lanham Act by allowing trademark registration for color alone.²⁰³ However, the Court was cautious and has created barriers to obtaining registration that may thwart applicants in obtaining federal registration in many instances. Chiefly, the Court noted that color alone trademarks are entitled to registration "where that color has attained 'secondary meaning' and therefore identifies and distinguishes a particular brand."²⁰⁴

One commentator, writing before the case was decided, noted that such a standard conflicts with the Court's prior ruling in *Two Pesos, Inc. v. Taco Cabana, Inc.*,²⁰⁵ which stated that inherently distinctive marks, i.e., marks that are not descriptive of the product, do not require secondary meaning.²⁰⁶ In *Qualitex*, the Court is essentially said that all color trademarks, whether they are descriptive of the product or not, require secondary meaning.

This broad requirement was likely born out of the understanding that color alone does not normally function as a trademark, but is rather seen by the consuming public as mere coloration. Since the Lanham Act requires that registered marks function as trademarks, forcing applicants to prove secondary meaning before issuing a registration ensures that only those color alone marks that are functioning as trademarks will be registered. Unfortunately, it may be difficult to build up the necessary consumer recognition sufficient to prove secondary meaning.²⁰⁷ In fact, it may take several years, during which time competitors may be able to take a free ride on any reputation (known as "goodwill")²⁰⁸ that the potential applicant has developed. Some courts have also recently rejected

203. See *supra* note 5 and accompanying text.

204. *Id.* at 1303.

205. 112 S. Ct. 2753 (1992).

206. See Landau, *supra* note 17, at 57-58.

207. See Keating, *supra* note 64, at 5-6, 17-18.

208. See RUDOLF CALLMANN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES*, § 1.11, at 1-36 (4th ed. 1994) ("Goodwill is not simply to be equated with reputation. It includes, but connotes more than, good credit, honesty, fair name and reliability").

the notion of "secondary meaning in the making," which aimed to provide limited protection while a producer was building up the necessary reputation, but had not yet achieved enough to gain full trademark status.²⁰⁹

This difficult situation of waiting to develop secondary meaning is not uncommon for descriptive marks, which require secondary meaning to be registered. However, non-descriptive marks²¹⁰ normally do not have that requirement and thus may obtain registration soon after their first use in commerce.²¹¹

To avoid the heavy burden of proving secondary meaning for all color marks before registration, the courts and the PTO should address the real issue for most color marks, which is whether or not the color is functioning as a trademark.²¹² If the color is merely descriptive of the goods, the functionality doctrine, or perhaps color depletion, may apply to block registration. But if an applicant is using a color that has absolutely nothing to do with the goods, the PTO should require the applicant to show that the color is being used *as a mark* and not merely as decoration, without the added requirement of secondary meaning. Use as a trademark can be shown by means of supporting advertising, as was done in the *Owens-Corning* case.²¹³

Of course, situations would arise in which the evidence of use as a mark would not be sufficient. If the applicant used several different colors, such as a variety of "designer" colors for the same product, and then attempted to claim a trademark in each separate color, then obviously, the color is not serving as a trademark. With the Supreme Court's decision in *Qualitex*, however, the courts and the PTO are bound to refuse registration to *any* color per se mark that has not gained secondary meaning. With the effort already ex-

209. See *Cicena Ltd. v. Columbia Telecoms. Group*, 900 F.2d 1546, 1549-50 (Fed. Cir. 1990).

210. These marks are usually considered "suggestive," "fanciful," or "arbitrary." See *Qualitex*, 115 S. Ct. at 1303 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2nd Cir. 1976)).

211. See 15 U.S.C. § 1051 (1988).

212. See *In re DC Comics, Inc.*, 689 F.2d 1042, 1050 (C.C.P.A. 1982).

213. See *supra* note 21 and accompanying text.

pending on trademark applications by the Examining Attorneys, they should be able to make the determination as to whether the color functions as a mark on a case-by-case basis.

CONCLUSION

In *Qualitex*, the United States Supreme Court followed the course set by the CAFC in *Owens-Corning* in 1985. By allowing color per se trademarks to be registered, the broad issue has been resolved. However, the limitations imposed on obtaining that registration will likely prevent many producers from achieving the full trademark protection that they deserve. It remains to be seen whether the *Qualitex* decision and its requirement for proof of secondary meaning will provide adequate protection for color per se trademarks.

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